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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/260,437 03/02/99 WALKER

J WD2-98-116

022927  
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TM02/0827

EXAMINER

CARLSON, J

ART UNIT

PAPER NUMBER

2162

DATE MAILED:

08/27/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

**Office Action Summary**

Application No.

09/260,437

Applicant(s)

WALKER ET AL.

Examiner

Jeffrey D. Carlson

Art Unit

2162

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 11 June 2001.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-34 and 70-72 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-34 and 70-72 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2,3.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

1. This action is responsive to the paper(s) filed 6/11/01.

#### ***Claim Rejections - 35 USC § 112***

2. Claims 26 and 27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

-- Claim 26, there is no clear antecedent basis for the account.

#### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-34 and 70-72 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnsen (US5250789) in view of Folio 2/1/92 (Holiday gift subs up, some due to novel promotions). Johnsen teaches in column 9 lines 25-33, the concept of optically scanning a product at the POS, searching a database for any rebates that match the product, displaying a message offering a rebate and printing a rebate form. Folio 2/1/92 teaches the idea of selling a product at a retail store, the product including an offer for a magazine subscription. It is well known and would have been obvious to one of ordinary skill at the time of the invention to have provided a rebate on specified

*Folio  
10 is part  
of novels*

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products of Folio 2/1/92, so that sales of slower-selling items could be invigorated. It would have been obvious to one of ordinary skill at the time of the invention to have stored the necessary rebate information in the POS accessible database so that a customer desiring such a magazine could be informed of the corresponding rebate, in a manner as taught by Johnsen. The printed rebate form would inherently include information about the rebate, including rebate identification so that it could be properly processed as is well known. Such printed coding reads on the code of applicant's claims. Johnsen teaches printing such "code(s)", which inherently includes outputting a signal representing the code. The combination teaches outputting an offer for a rebate in exchange for establishing a subscription. The coding/printing is specific to the particular rebate in the database and is selected from the totality of coding/printing associated with all of the stored rebate offers. It would have been obvious to one of ordinary skill at the time of the invention to have created an authentication code associated with the particular rebate printout so as to discourage/prevent unauthorized rebate use/abuse; it would have been obvious to one of ordinary skill at the time of the invention to have generated such a code randomly or via encryption of known values related to the rebate so that the numbering scheme that validates the rebate cannot be easily guessed or predicted, thus preventing counterfeiting. It would have been obvious to one of ordinary skill at the time of the invention that the printing/coding of the rebate offer would include valid dates, productID, product description as well as contact info such as rebate provider, telephone help line, address, phone number, etc as is known with rebates. The printed rebate form is inherently a machine readable message

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(specific to the item), however, it would have been obvious to one of ordinary skill at the time of the invention to have provided the necessary info such as valid dates, productID, product description, etc as is known with rebates as bar-coded data so as to more efficiently enable processing. It is well known to pay for items at a POS by swiping a credit card and would have been obvious to one of ordinary skill at the time of the invention to have done so. Such a credit card transaction inherently includes receiving an accountID. Regarding claim 22, the subscription offered is related to/based on the magazine package title selected for purchase. Claim 23 is met at least by the database search for a valid rebate (offer rebate if matching rebate is found). Regarding claim 31, the subscription package ultimately includes an issue of the magazine. Further, it would have been obvious to one of ordinary skill at the time of the invention to have bundled the subscription package with the current issue of the magazine to encourage impulse purchases for those who pick up and leaf through the current issue. Regarding claim 33 and 34, it would have been obvious to one of ordinary skill at the time of the invention to have provided text describing the magazine offer and/or numeric dates and/or numeric pricing with the printing/coding on the rebate form printout.

5. Claims 5-9 are alternatively rejected under 35 U.S.C. 103(a) as being unpatentable over Johnsen and Folio 2/1/92 as applied to claim 1 above, and further in view of Flaten (US5467269). Flaten teaches in column 2 lines 46-56 the use of codes printed on coupons or rebate forms such as productID, storied, manufacturerID, retailerID, etc to supply valuable marketing and routing information to the system. It

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would have been obvious to one of ordinary skill at the time of the invention to have provided these and/or other related codes/printing with the rebate form of Johnsen.

### ***Conclusion***

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Fajkowski (US5905246) teaches in columns 5 and 25 the determination of available rebates at the POS.
- Johnson (US5924080) teaches rebate printouts made at the POS with customer receipt.
- Holda-Fleck (US5729693) teaches using a phone system to apply for a rebate using productID and productSN.
- "US News' rebate offer under fire" teaches an offer to subscribe to a magazine and receive a rebate for the single issue price paid.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey D. Carlson whose telephone number is 703-308-3402. The examiner can normally be reached on 8:30-6p, off on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on 703-305-8469. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-6606 for regular communications and 703-305-6606 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.



Jeffrey D. Carlson  
Examiner  
Art Unit 2162

jdc  
August 22, 2001